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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/488,337	01/20/2000	Evgeniy M. Getsin	IACTP010	4283

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EXAMINER	
AVELLINO, JOSEPH E	

ART UNIT	PAPER NUMBER
2143	

DATE MAILED: 06/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/488,337	GETSIN ET AL.	
	Examiner	Art Unit	
	Joseph E. Avellino	2143	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *16 May 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-24* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-24* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-24 are presented for examination; claims 1, 7, 13, and 19 independent.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., In re Berg, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); In re Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); In re Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-24 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-13 of U.S. Patent No. 6,769,130 (hereinafter '130) in view of Ludwig et al. (USPN 5,978,835) (hereinafter Ludwig). '130 discloses providing an event stored in memory on the client apparatuses, transmitting a command from the host to the clients, and storing information on the host computer for allowing the simultaneous playback of the event from the memory on each of the client apparatuses (e.g. claim 1), and further discloses including a history of the simultaneous

playback, however does not disclose that the history information can be downloaded for playback after the simultaneous playback. In analogous art, Ludwig discloses another method for storing synchronization information comprising the steps of:

storing content (i.e. recorded audio and video) and timing information (i.e. timestamps) transmitted during the simultaneous playback of the event at the host computer (col. 33, lines 45-50); and

allowing the content and timing information to be downloaded utilizing the network for playback of said event and said downloaded content and timing information after the simultaneous playback (MMCR call conference recordings are passed to the MMDM system which allows the documents to be searched and downloaded) (col. 3, lines 5-25; cols. 33-34).

It would be obvious to a person of ordinary skill in the art at the time the invention was made to combine the teaching of Ludwig with Roberts in order to replay the collaboration with accurate correspondence in time to the recorded audio and video, thereby liberating the participants from the limitations of time and distance as supported by Ludwig (e.g. abstract; col. 33, lines 45-50).

Claims 1-24 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-18 of U.S. Patent No. 6, 941,383 (hereinafter '383) in view of Ludwig. '383 discloses providing an event stored in memory on the client apparatuses (e.g. in a DVD player), transmitting a command from the host (e.g. server) to the clients, and storing information on the host computer for

allowing the simultaneous playback of the event from the memory on each of the client apparatuses (e.g. claim 1),however does not disclose that the history information can be downloaded for playback after the simultaneous playback. In analogous art, Ludwig discloses another method for storing synchronization information comprising the steps of:

storing content (i.e. recorded audio and video) and timing information (i.e. timestamps) transmitted during the simultaneous playback of the event at the host computer (col. 33, lines 45-50); and

allowing the content and timing information to be downloaded utilizing the network for playback of said event and said downloaded content and timing information after the simultaneous playback (MMCR call conference recordings are passed to the MMDM system which allows the documents to be searched and downloaded) (col. 3, lines 5-25; cols. 33-34).

It would be obvious to a person of ordinary skill in the art at the time the invention was made to combine the teaching of Ludwig with Roberts in order to replay the collaboration with accurate correspondence in time to the recorded audio and video, thereby liberating the participants from the limitations of time and distance as supported by Ludwig (e.g. abstract; col. 33, lines 45-50).

Claims 1-24 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-48 of U.S.

Application No. 10/880,272 in view of Ludwig. The rationale can be found in above for the rejection by '130 in view of Ludwig. This is the continuation of '130.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roberts et al. (hereinafter Roberts) (USPN 6,161,132) in view of Ludwig.

3. Referring to claims 1, 7, and 13, Roberts discloses a method for storing synchronization information for subsequent playback of an event on a plurality of client apparatuses, comprising the steps of:

providing an event stored in memory on at least one of the client apparatuses, wherein the client apparatuses and a host computer (server) are adapted to be connected to a network (Internet) (col. 7, line 30 to col. 8, line 2);

storing information on the host computer for allowing the simultaneous playback of the event from the memory on each of the client apparatuses (col. 7, line 30 to col. 8, line 2);

Roberts does not disclose storing content and timing information transmitted during the simultaneous playback of the event at the host computer, and allowing the content and timing information to be downloaded utilizing the network for playback of

said event and said downloaded content and timing information after the simultaneous playback. In analogous art, Ludwig discloses another method for storing synchronization information comprising the steps of:

storing content (i.e. recorded audio and video) and timing information (i.e. timestamps) transmitted during the simultaneous playback of the event at the host computer (col. 33, lines 45-50); and

allowing the content and timing information to be downloaded utilizing the network for playback of said event and said downloaded content and timing information after the simultaneous playback (MMCR call conference recordings are passed to the MMDM system which allows the documents to be searched and downloaded) (col. 3, lines 5-25; cols. 33-34).

It would be obvious to a person of ordinary skill in the art at the time the invention was made to combine the teaching of Ludwig with Roberts in order to replay the collaboration with accurate correspondence in time to the recorded audio and video, thereby liberating the participants from the limitations of time and distance as supported by Ludwig (e.g. abstract; col. 33, lines 45-50).

4. As to claims 2, 8, and 14, Roberts discloses the invention substantially as discussed in the claim 1 rejection, including the event includes a video and audio presentation (col. 2, lines 5-26).

5. As to claims 3, 9, and 15, Roberts discloses a method for storing synchronization information as stated above. Roberts does not disclose the information includes a history and data associated with the simultaneous playback. Ludwig discloses the information includes a history and data associated with the simultaneous playback (i.e. MMCR document stores all calls and captures all audio and video) (col. 33, lines 50-60). It would be obvious to a person of ordinary skill in the art at the time the invention was made to combine the teaching of Ludwig with Roberts in order to replay the collaboration with accurate correspondence in time to the recorded audio and video, thereby liberating the participants from the limitations of time and distance as supported by Ludwig (e.g. abstract; col. 33, lines 45-50).

6. As to claims 4, 10, and 16, Roberts- Ludwig discloses the invention substantially as discussed in the claim 1 rejection, including the network is a wide area network (Roberts, col. 1, lines 57-61). The Office takes the Internet to be synonymous with a wide area network.

7. As to claims 5, 11, and 17, Roberts- Ludwig discloses the invention substantially as discussed in the claim 1 rejection, including the memory includes a digital video disc (DVD) (Roberts, col. 2, lines 5-18).

8. As to claims 6, 12, and 18, Roberts- Ludwig discloses the invention substantially as discussed in the claim 1 rejection, including the information includes chapter

information associated with the DVD (Roberts, col. 4, lines 1-20). The term "track" can be considered equivalent to a chapter on a DVD since DVD movies are segmented into chapters such as audio CD's are segmented into audio tracks.

9. Claims 19-24 are rejected for similar reasons as stated above.

Response to Amendment

10. Applicants arguments dated May 16, 2006 have been fully considered but are not persuasive.

11. IN the remarks, Applicant argues, in substance, that (1) Ludwig teaches away from storing content and timing information for playback with locally stored event because Ludwig is specifically directed to real time conference calls and not a locally stored event, and there would be no reason to reference local content.

12. As to point (1) Applicant is incorrect. Applicant should be made aware that the rejection is of Roberts *in view of* Ludwig. As stated above, Roberts discloses a multimedia conference (i.e. chat room) occurring in real time with the CD playing in chat room client's machines, which is controlled by the chat plug-in that is approximately synchronized to the CD which is playing in the other chat room client's machines (col. 7, line 30 to col. 8, line 2). Ludwig discloses another multimedia conference which is *recorded* (see cols. 33-34). It is the combination of the two references which meets the

limitations of the claimed invention. Applicant should be aware that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). As such, since proper motivation has been provided to combine the teaching of Ludwig with Roberts, a *prima facie* case of obviousness of the claimed invention has been provided. By this rationale, the rejection is maintained.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph E. Avellino whose telephone number is (571) 272-3905. The examiner can normally be reached on Monday-Friday 7:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JEA
May 23, 2006

DAVID WILEY
SUPERVISORY PATENT EXAMINER
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